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IN THE  
**Supreme Court of the United States**

OCTOBER TERM, 1944.

No. **486**

THE HOOVER COMPANY,

*Petitioner,*

*vs.*

CONWAY P. COE, COMMISSIONER OF PATENTS,

*Respondent.*

**BRIEF OF J. BERNHARD THIESS UPON BEHALF OF  
PAUL A. STURTEVANT, AS AMICUS CURIAE.**

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**PRELIMINARY STATEMENT.**

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Paul A. Sturtevant, for whom *amicus curiae* is counsel, is the plaintiff in an action now pending in the District Court of the United States for the District of Columbia entitled "*Paul A. Sturtevant, plaintiff, v. Conway P. Coe, Commissioner of Patents, defendant*, Civil Action No. 22,403." In that action, commenced on December 13, 1943, the plaintiff seeks a decree of the District Court authorizing and directing the defendant to issue to plaintiff a reissue patent embodying certain claims which were refused to plaintiff by the Board of Appeals of the Patent Office on the ground that they were not readable upon the

disclosure of the plaintiff's application. Issue was duly joined and the case was awaiting trial when the decision in the instant case was rendered.

On September 27, 1944, the respondent here—the defendant in the aforesaid action—moved to dismiss the complaint on the ground that “the Court lacks jurisdiction to grant the relief sought,” the sole basis of the motion being the decision in the instant case. The said motion is pending and undetermined, and obviously the decision of this Court in the case at bar affects the case in which *amicus curiae* is interested. He therefore desires to present an argument as an aid to this Court in its consideration of the instant petition and to urge respectfully that this Court should exercise its supervisory authority by granting its writ of certiorari to review the judgment of the Court below.

## THE IMPORTANCE OF THE QUESTIONS PRESENTED.

Ever since *Gandy v. Marble*, 122 U. S. 432, it has been accepted practice that a decree entered by a court of equity in an action under § 4915, Revised Statutes,<sup>1</sup> was not so far conclusive upon the Commissioner of Patents that upon filing of a copy of the decree with him he had no alternative but to comply therewith immediately and issue the patent as directed.

The statute merely provides that a successful plaintiff is only entitled to a patent upon "filing in the Patent Office a copy of the adjudication and **otherwise complying with the requirements of law,**" and construing this language in *Gandy v. Marble*, this Court said (p. 440):

" . . . All that the court which takes cognizance of the bill in equity, under § 4915, is authorized to do is to adjudge whether or not 'the applicant is entitled, according to law, to receive a patent,' and, **after an adjudication in his favor to that effect, the Commissioner is not authorized to issue a patent unless the applicant otherwise complies with the requirements of law.**"

In view of the foregoing decision, as well as the clear language of the statute, the right of the Commissioner of Patents to refuse to execute the decree entered in a § 4915 action if the successful plaintiff fails to pay the fees required by law or to meet other conditions required of him by the patent statutes and the rules of the Patent Office cannot be challenged. Similarly the decree for all practical purposes is rendered a nullity where after its filing the Commissioner of Patents, while preparing to issue a patent, discovers the pending application of another claiming the same subject matter and is consequently required

1. Appendix, *post*, pp. 27-28.

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by law to declare an interference. It clearly appears from the memorandum which was presented by respondent to the Court below,<sup>2</sup> that the administrative practice of the Patent Office consistently pursued throughout the years was admittedly contrary to the practice now dictated by the instant decision. By way of aiding the Court below in its construction of the statutes involved, respondent informed the Court of the existence of an administrative interpretation of long standing that, upon the filing of an adjudication favorable to an applicant, the Patent Office claimed the right to exercise, and did actually exercise, its prerogative "to proceed in accordance with other sections of the patent statutes." It was pointed out to the Court that while the language of § 4915 might appear to make the adjudication mandatory and immediately effective, it was thought "that it is proper to consider it as a part of the entire patent law, and hence, coordinate with section 4904 R.S., which provides for the declaration of an interference where an application for patent is found to be in conflict with another application or an unexpired patent. It is not until it is found that a claim in an application is patentable to the applicant that such a conflict exists. Therefore, when it is determined by the adjudication of the court that the conflict exists, section 4904 R.S. comes into play and the interference must be declared, notwithstanding the form of the judgment."<sup>3</sup>

2. For the benefit of the Court this memorandum is printed *in toto* in the Appendix, *post*, pp. 29-33.

3. Respondent called attention to the fact that, under prevailing administrative practice, interferences have been declared by the Patent Office upon the filing of an adjudication that an applicant was entitled to receive a patent. Thus the Court was informed that, after the decree entered in *Tully v. Robertson*, 19 F. (2d) 954, where the right of an applicant to copy claims from an unexpired patent and thus provoke an interference had been upheld, the interference was declared, notwithstanding the adjudication in favor of the plaintiff. Attention was specifically

In the face of this administrative interpretation by the Commissioner of Patents, and despite these unambiguous representations by him that no practical obstacles have been or are presented by a decree adjudging that an applicant is entitled to receive a patent, the Court below nevertheless refused to assume jurisdiction of an action under § 4915 because it considered that its decree could not be immediately carried out, but instead would result in an interference. The Court below, holding that it was powerless to determine petitioner's "right to a patent" because it involved deciding that he is prior to another applicant,—not before the Court—concluded that the "whole controversy" had not been presented and that consequently there was no jurisdiction.

Thus not only is the question decided by the Court below of general importance, but it is one of substance relating to the construction of statutes of the United States which has not been, but should be, settled by this Court. We respectfully submit, moreover, that the Court below has not given proper effect to applicable decisions of this Court and that the instant decision, if erroneous, will produce unfortunate consequences in practice.

In *Butterworth v. Hill*, 114 U. S. 128, it was held by this Court that an action under § 4915 may not be maintained against the Commissioner of Patents without his consent, where he is the sole defendant, save in the district of his official residence, and consequently it is within the power of respondent to require that all actions by applicants to

called to *International Cellucotton Products Co. v. Coe*, 85 F. (2d) 869, and *American Cyanamid Co. v. Coe*, 106 F. (2d) 851. In those cases, after the dissolution of interferences set up by the Patent Office, the applicants on the *ex parte* prosecution of the application were refused certain claims on the ground of estoppel. Actions under § 4915 were successfully prosecuted and upon the filing of the favorable adjudications the interferences were re-declared and prosecuted to decision.



whom patents are refused in *ex parte* cases be brought in the District Court for the District of Columbia. Hence the nature of the questions presented and the improbability that other inferior courts will ever have an opportunity to pass upon these identical questions should move this Court to grant the instant petition (cf. *Paramount Publix Corp. v. American Tri-Ergon Corp.*, 294 U. S. 464; *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U. S. 47; *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U. S. 126).

## SUMMARY OF ARGUMENT.

### I.

The decision below is contrary to the clear and unambiguous language of the statute and is in conflict with a liberal legislative policy calculated to afford applicants for patents ample remedy by a suit in equity in every case where a patent has been refused. A review of the legislation dealing with the subject of a remedy by bill in equity reveals a Congressional purpose, more than a century old, favoring the right of a defeated applicant for a patent to secure a review in a court of equity of the action of the Patent Office in refusing a patent for any reason whatever.

Orderly procedure dictates, contrary to the views of the Court below, that where an applicant for a patent desires to provoke an interference with a previously granted unexpired patent the right to contest priority with the patentee of the existing patent should be first established. Hence, a decision of the Patent Office denying to an applicant the right to conduct an interference with an existing patent is in the very nature of things the type of final refusal of a patent which courts may review in an action under § 4915. The power of Congress to provide for judicial interference with the action of the Patent Office, either upon refusal of a patent or at any stage of an interference proceeding which results in the refusal of a patent, cannot be successfully challenged. (*United States v. Duell*, 172 U. S. 576.)

### II.

The decision below misapplies the decisions of this Court in *Hill v. Wooster*, 132 U. S. 693 and *Butterworth v. Hoe*, 112 U. S. 50, and is contrary to the rule of construction



adopted by this Court in *Baldwin Co. v. Robertson*, 265 U. S. 168. Neither of the cases relied upon by the Court below directly or indirectly involved the jurisdictional questions here presented. From the *Baldwin* case it clearly appears that the purpose of § 4915 is to afford to a defeated applicant for a patent a remedy in equity against the Commissioner in every case to the end that the final action of the Commissioner may always be subjected to independent judicial review. The assumption by the Court below that the nature of the relief which may be granted in a § 4915 action is circumscribed by the language of the statute and by principles of equity jurisdiction does not square with the rule of construction adopted in the *Baldwin* case and, moreover, ignores the fundamental power of Congress to provide for remedies, by way of appeal or otherwise, in respect of interlocutory as well as final decisions.

### III.

The decision below adopts a rule of construction which nullifies the Congressional purpose to provide alternative remedies to defeated applicants for patents and which is contrary to an interpretation of the same statutes made by the courts of the Second and Third Circuits. §§ 4911 and 4915 have been amended to provide that if an applicant who has been refused a patent appeals to the Court of Customs and Patent Appeals he waives his right to proceed under § 4915. It is not disputed that a direct appeal lies in a case where an applicant has been refused a patent on the ground that he had no right to make the claims requested; *a fortiori* he has the right to secure a review of the Patent Office refusal in a § 4915 action. Any other construction deprives an applicant for patent of rights clearly expressed in the statutes.

## ARGUMENT.

### I.

THE DECISION BELOW IS CONTRARY TO THE CLEAR AND UN-  
AMBIGUOUS LANGUAGE OF THE STATUTE AND IS IN CONFLICT  
WITH A LIBERAL LEGISLATIVE POLICY CALCULATED TO AFFORD  
APPLICANTS FOR PATENTS AMPLE REMEDY BY A SUIT IN  
EQUITY IN EVERY CASE WHERE A PATENT IS REFUSED.

The enactment now found in the Statutes of the United States on the subject of the availability to a defeated applicant for a patent of a remedy by suit in equity is the result of a long course of legislation. A review of this background plainly reveals a liberal legislative policy inconsistent with the narrow and restricted view which was taken by the Court below. However plausible Judge Arnold's arguments may be, the construction imposed by him upon the statute involved does not square with the words actually used in the statute and is in obvious conflict with its general Congressional purpose.

The first legislation dealing with a suit in equity by an applicant who had been refused a patent is found in the Patent Act of 1836. (Act of July 4, 1836, ch. 357, 5 Stat. 117).<sup>4</sup> By § 7 of that Act the Commissioner of Patents was authorized, on the filing of an application for patent, to make an examination of the alleged new invention or discovery and it was declared to be his duty to issue a patent if he "shall deem it to be sufficiently useful and important"; in case of the Commissioner's refusal to issue a patent, the applicant was secured an appeal from this decision to a board of examiners. The decision of this board being certified to the Commissioner, it was declared that

4. Appendix, *post*, pp. 23-25.

"he shall be governed thereby in the further proceedings to be had on such application." By § 8 it was provided that if in the opinion of the Commissioner an application "would interfere with any other patent for which an application may be pending, or with any unexpired patent which shall have been granted" he was authorized, after notice to the parties, to decide the "question of priority of right or invention." An appeal to the board of examiners as in the case of other refusals was provided in these cases of interference. § 16 of the Act<sup>5</sup> provided, in part:

"That . . . whenever a patent on application shall have been refused on an adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted, . . . any such applicant . . . may have remedy by bill in equity, and the court having cognizance thereof . . . may also adjudge that such applicant is entitled, according to the principles and provisions of this act, to have and receive a patent for his invention as specified in his claim, or for any part thereof, as the fact of priority of right or invention shall in any such case be made to appear. . . ."

It will thus be observed that as enacted this section limited the "remedy by bill in equity" to cases of interference. The right of an applicant to appeal to the courts to review the action of the Patent Office was available only when the application had been refused "on an adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted." In all other cases the decision of the board of examiners was final. No provision had been made for an independent judicial review in those cases.

5. Appendix, *post*, p. 24. It should be mentioned that this section also related to a suit in equity "whenever there shall be two interfering patents." The proceedings were separated by the Act of 1870 (C. 230, 16 Stat. 198, §§ 52, 58). Actions relating to interfering patents are now covered by § 4918 (35 U. S. C., § 66).

By § 10 of the Patent Act of 1839 (Act of March 3, 1839, ch. 88, 5 Stat. 353), the provisions of § 16 of the Act of 1836 were extended to *all cases* where patents were refused "*for any reason whatever*," either by the Commissioner of Patents or by the Chief Justice of the District of Columbia, upon appeals from the decisions of the Commissioner, "as well as where the same shall have been refused on account of, or by reason of, interference with a previously existing patent."

Thus there was evinced by Congress more than a century ago an intention to make available to persons seeking patents the right to secure, by bill in equity, an independent judicial review in all cases where the Patent Office had refused a patent *for any reason whatever*. It would seem that all argument might therefore well close here, for only compelling language could justify a conclusion that Congress intended to abandon its avowed policy and, as will presently appear, no subsequent enactment of Congress has taken away any of the comprehensive power clearly conferred upon the courts at that early date.

By the Consolidated Patent Act of 1870 (Act of July 8, 1870, ch. 230, 16 Stat. 198) the provisions of § 16 of the Act of 1836 and of § 10 of the Act of 1839 were combined into § 52 of that Act, as follows:

"Section 52. *And be it further enacted*, That whenever a patent on application is refused, *for any reason whatever*, either by the commissioner or by the Supreme Court of the District of Columbia upon appeal from the commissioner, the applicant may have remedy by bill in equity; and the court having cognizance

6. By § 11 it was provided that in all cases where an appeal was then allowed by law from the decision of the Commissioner of Patents to a board of examiners, an applicant, instead thereof, should have a right of appeal to the Chief Justice of the District Court of the United States for the District of Columbia. See Appendix, *post*, p. 25.

7. Appendix, *post*, p. 25.

thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, *as the facts in the case may appear.*<sup>8</sup> And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent, on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requisitions of law."

In view of the language of the prior enactments and especially in view of the provision in § 52 of the Act of 1870 that the remedy by bill in equity was available in the case of a refusal "for any reason whatever," a Congressional purpose in favor of the applicant in all cases, far from being shown to have receded, is clearly carried forward. The right to a "remedy by bill in equity" in all cases was thus emphasized once more.

When the Statutes were revised in 1874, we find that the words "for any reason whatever" appearing in § 52 of the Act of 1870 were omitted from § 4915 (Act of June 22, 1874; § 4915);<sup>9</sup> but certainly no one will contend that there is any difference between the words "*refused* for any reason whatever", as was provided in the Act of 1870, and the word "*refused*", as specified in § 4915. It must be conclusively presumed that the revisers of the Statutes recognized the equality of the expressions. It cannot be implied that any detracting of the right to a "remedy by bill in equity" was intended or that any decrease in the jurisdiction of the courts to make an independent judicial review flows from the deletion of the words "for any reason whatever."

8. The italicized words constitute a broadening and significant departure from the limited language of the predecessor statute, i. e., "as the fact of priority of right or invention shall in any such case be made to appear." (See *ante*, p. 10.)

9. Appendix, *post*, p. 27.



If, originally, jurisdiction was conferred upon the courts solely for the purpose of reviewing and correcting refusals based on account of interference with a previously existing patent, and if such jurisdiction was subsequently extended to *all cases* where patents had been refused "for any reason whatever," we can see no justification for now holding that the Federal Courts have no jurisdiction because the issue of priority between an applicant and an existing patent is not also presented for determination. Such an issue was the only one which originally could have invoked the remedy by suit in equity, but the jurisdiction of the courts was subsequently expanded to apply to refusals on other grounds, and it does violence to a clearly expressed legislative policy to hold, as did the Court below, that jurisdiction is wanting merely because the priority issue as between the applicant and a known unexpired patent is not presented.

There is no difference in principle between an action under § 4915 followed by a declaration of an interference between the successful plaintiff and an applicant not previously known or contemplated and an action which is avowedly prosecuted in order to lay the foundation for the declaration of an interference with an existing patent with which the defeated applicant desires to contest priority. In the former case, the courts admittedly have jurisdiction. No decision—prior to that of the Court below—has questioned the right of a person seeking a patent to prosecute a bill in equity in the latter case.

Orderly procedure dictates, contrary to the views of the Court below, that where an interference with an unexpired patent is being provoked, the prior patentee should not be required to litigate until the defeated applicant has established his right to the claims and to an interference. Thus in *Robinson on Patents* (Vol. 2, § 722, p. 463), that eminent patent law authority, commenting upon the separation by

the Act of 1870 of proceedings involving interfering patents and those involving an applicant and a patent, said:

"\* \* \* The grant of a patent raises a strong *prima facie* presumption of its validity. The refusal of a patent by the Patent Office is also *prima facie* evidence that the applicant has no right to a monopoly. To permit a defeated applicant to attack an interfering patent in the face of these two presumptions is inconsistent with a due regard to the rights of the existing patentee. Not until he has overcome the presumption arising from his own defeat by obtaining a reversal of the adverse judgment, and by the allowance of a patent in his favor has put himself on equal ground with the earlier patentee, ought he to be permitted to bring his adversary into court in defense of the prior patent, or compel him to incur the risk of its repeal. The present law thus adequately protects the interests of all parties, and far more accurately than the old preserves a proper order and sequence in its remedies."

The decision of the Court below also seemingly questioned both the power and purpose of Congress to provide for a review by bill in equity of an administrative ruling made in the preliminary stage of an interference and thus imputes a Congressional intent not to affect the principles of equity jurisdiction.

A forcible statement of the principle applicable here was made in *United States v. Duell*, 172 U. S. 576, when Mr. Chief Justice Fuller said (p. 583):

"Since, under the Constitution, Congress has power 'to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries,' and to make all laws which shall be necessary and proper for carrying that expressed power into execution, it follows that Congress may provide such instrumentalities in respect of securing to inventors the exclusive right to their discoveries as in its judgment will be best calculated to effect that object."

In that case it was held that the competency of Congress to provide for "judicial interference" with the action of the Patent Office cannot be successfully questioned as being an encroachment upon the judicial department. Hence, the view of the Court below that assumption of jurisdiction in a case like the present one, is "contrary to the fundamental concept of equity jurisdiction" is in conflict with the holding in *United States v. Duell*, that:

"\* \* \* The nature of the thing to be done being judicial, Congress had power to provide for judicial interference through a special tribunal, *United States v. Coc*, 155 U. S. 76; and *a fortiori* existing courts of competent jurisdiction might be availed of."

## II.

THE DECISION BELOW MISAPPLIES THE DECISIONS OF THIS COURT IN *HILL V. WOOSTER*, 132 U. S. 693, AND *BUTTERWORTH V. HOE*, 112 U. S. 50, AND IS CONTRARY TO THE RULE OF CONSTRUCTION ADOPTED BY THIS COURT IN *BALDWIN CO. V. ROBERTSON*, 265 U. S. 168.

The Court below, asserting that there were no "controlling decisions" applicable to the question which the Court had raised *sua sponte*, proceeded to resolve the question in the light of "considerations of sensible and orderly procedure" and justified its action by the ruling of this Court in *Hill v. Wooster*, 132 U. S. 693, and certain language in this Court's decision in *Butterworth v. Hoe*, 112 U. S. 50. The Court below concluded that unless a court to whom a petition is addressed under § 4915 can determine the whole controversy on its merits, jurisdiction cannot be assumed. The principal reason advanced is that where an interference with another person—not before the court—appears as a possibility, the court cannot adjudge, within the language of § 4915, that the plaintiff "is entitled according to



law to receive a patent." The Court thus not only took an unrealistic view of the practice pursued for many years, but also it ignored a long standing administrative interpretation of the statute. (*ante*, pp. 4-5.)

In *Hill v. Wooster*, it was merely held that in an *inter partes* action under § 4915, the court, in spite of the wishes of the parties, has the power to declare the subject matter of the interference unpatentable. In *Butterworth v. Hoe*, this Court merely defined the nature of the action contemplated by § 4915 and, in emphasizing the *de novo* character of such an action, distinguished it from an appeal under § 4911.<sup>10</sup> Neither case even remotely touched upon the jurisdictional question here presented.

Moreover, the suggestion that jurisdiction cannot be assumed because of the preliminary stage at which the Patent Office ruling was made ignores the fundamental power of Congress to provide for appeals from interlocutory orders in any case or controversy and especially the power of Congress to provide for judicial interference with the administration of the business of the Patent Office.

In circumscribing the nature of the relief which a court in a § 4915 action has the power to grant, the Court below has, however, placed itself squarely in conflict with the decision of this Court in *Baldwin Co. v. Robertson*, 265 U. S. 168.

By way of preface to an explanation of that case, it should be mentioned that in *Atkins & Co. v. Moore*, 212 U. S. 285, 291, *American Steel Foundries v. Robertson*, 262 U. S. 209, and *Baldwin Co. v. Howard Co.*, 256 U. S. 35, 39, this Court held that the assimilation of the practice in re-

<sup>10</sup> See also *Morgan v. Daniels*, 153 U. S. 120, for further emphasis of the datum that a proceeding under § 4915 is not a "mere appeal."

spect of the registration of trade marks to that in securing patents as enjoined by § 9 of the Trade Mark Act (33 Stat. 727, c. 592) made § 4915, providing for a bill in equity to compel the Commissioner of Patents to issue a patent, applicable to a petition for the registration of a trade mark when rejected by the Commissioner.

The case presented in *Baldwin Co. v. Robertson* involved, however, not a bill under § 4915 to review and correct the action of the Commissioner in refusing a trade mark registration, but instead, a bill under that section seeking an *injunction*, to prevent the Commissioner from cancelling certain trade marks which had already been registered by the plaintiff. *Thus the case was not one wherein the court was requested to adjudge that the plaintiff was entitled to receive a trade mark registration.*

Against jurisdiction to entertain such a bill it was expressly argued in *that case* that § 4915 did not authorize the action (p. 169) and that to interpret § 4915 as authorizing the action "requires a rewriting of § 4915, and the incorporation into the section of both words and subject matter entirely foreign to its present plain language" (p. 171). Rejecting these contentions, Mr. Chief Justice Taft said (265 U. S. 179):

"The next inquiry is whether, in addition to such appeal and after it proves futile, the applicant is given a remedy by bill in equity as provided for a defeated applicant for a patent in § 4915, Rev. Stats. We have in the cases cited given the closing words of § 9 a liberal construction in the view that Congress intended by them to give every remedy in respect to trade marks that is afforded in proceedings as to patents, and have held that under them a bill of equity is afforded to a defeated applicant for trade mark registration just as to a defeated applicant for a patent. **It is not an undue expansion of that construction to hold that**

the final words were intended to furnish a remedy in equity against the Commissioner in every case in which by § 9 an appeal first lies to the Court of Appeals. This necessarily would give to one defeated by the Commissioner as a party to an application for the cancellation of the registration of a trade mark, after an unsuccessful appeal to the advisory supervision of the Court of Appeals, a right to resort to an independent bill in equity against the Commissioner to prevent cancellation."

*Baldwin Co. v. Robertson* clearly reveals that the purpose of § 4915 is to afford a defeated applicant for patent an independent judicial review in every case where the Patent Office has made a final adverse decision. It demonstrates, moreover, the error into which the Court below fell when it assumed that the only power under § 4915 which a court has is that of making a decree authorizing and directing the Commissioner to issue a patent. If a court may enter an injunction in the exercise of its jurisdiction under § 4915, then *a fortiori* it may make a decree "directing the Commissioner to find claims readable on plaintiff's disclosure and allowable to him provided that later he is determined to have priority."

### III.

THE DECISION BELOW ADOPTS A RULE OF STATUTORY CONSTRUCTION WHICH NULLIFIES THE LEGISLATIVE PURPOSE TO PROVIDE ALTERNATIVE REMEDIES TO DEFEATED APPLICANTS FOR PATENTS AND WHICH IS CONTRARY TO THE INTERPRETATION OF THE SAME STATUTE MADE BY THE COURTS OF THE SECOND AND THIRD CIRCUITS.

By the Act of March 2, 1927 (Chap. 273, §§ 8, 11, 44, Stat. 1336), §§ 4911 and 4915 were amended to provide that if an applicant for patent appealed to the Court of Ap-

peals of the District of Columbia," he waived his right to proceed under § 4915.

Thus § 4911 provides that an applicant may have a direct appeal to the Court of Customs and Patent Appeals but that, in that case, "he waives his right to proceed under Section 63" (§ 4915) and § 4915 provides that if an appeal is taken or is pending or is decided "no action may be brought under this section" (Appendix, *post*, pp. 26-28).

These amendments have been regarded as providing alternative remedies for an applicant who is dissatisfied with the decision of the Board of Appeals or the Board of Interference Examiners. Thus Rule 149 of the Patent Office provides:

"If an applicant in an *ex parte* case appeals to the U. S. Court of Customs and Patent Appeals he waives his right to proceed under section 4915 R. S. (U. S. C. Title 35, sec. 63).

"From adverse decisions by the board of appeals in *ex parte* cases and from decisions of the board of interference examiners, the appellant, if an applicant, has the option of proceeding under section 4915 R. S. instead of appealing directly to the U. S. Court of Customs and Patent Appeals."

The Court below refused to recognize the 1927 amendments or to sanction the Patent Office rule. Indeed, it was held, in effect, that the petitioner's remedy in the instant circumstances resided solely in an appeal to the United States Court of Customs and Patent Appeals. If it be conceded that an appeal in the instant case lay to that court, then by the clear language of §§ 4911 and 4915,

\* 11. In 1929, the jurisdiction of this Court to entertain a direct appeal was transferred to the U. S. Court of Customs and Patent Appeals. Hence, the references in these sections to the Court of Appeals of the District of Columbia were changed to read "United States Court of Customs and Patents Appeals" (Act of March 2, 1929, c. 488, § 2, 45 Stat. 1476).

the remedy by bill in equity is also available. Those sections clearly provide alternative remedies for reviewing a refusal to issue a patent and have been so construed in cases arising in other circuits.

Thus in *Bakelite Corp. v. National Aniline & Chemical Co.* (C. C. A. 2), 83 F. (2d) 176, 177, the court said:

"It cannot be doubted that the statute, as it now reads, **means to give alternative remedies to an applicant to whom a patent has been refused.** He may appeal, 'in which case he waives his right to proceed under section 63 of this title' (35 U. S. C. A. § 59a); or (he may have his remedy by bill in equity, 'unless appeal has been taken from the decision of the board of appeals to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section.' (35 U. S. C. A. § 63.)"

In *General Talking Pictures Corp. v. American Tri-Ergon Corporation, et al.* (C. C. A. 3), 96 F. (2d) 800, 812, the court referring to the 1927 Amendment said (p. 812):

"In our opinion the amendment has two practical results:

"First, it provides that the losing party in an interference is not entitled to his remedy by suit if an appeal to the United States Court of Customs and Patent Appeals is pending or has been decided."

The logic of the contention that if an applicant is refused a patent on the ground that the claims do not read upon his disclosure he has the right to appeal to the Court of Customs and Patent Appeals, then he also has the right to secure a review of the same type of refusal by way of a suit in equity under § 4915 cannot be disputed. It is based upon the *alternative* and *optional* character of those remedies as provided by Congress. The force of a similar contention was recognized in *Baldwin Co. v. Robertson, supra*, when it was held that it was not an undue expan-



sion of the statute to hold that a remedy in equity against the Commissioner was furnished "in every case in which by § 9 an appeal first lies to the Court of Appeals."

The construction which has been imposed upon §§ 4911 and 4915 by the Court below deprives an applicant whose claims, copied from an unexpired patent, have been refused, from availing himself of the right clearly expressed in § 4915 to file a "bill in equity" instead of taking an appeal to the United States Court of Customs and Patent Appeals.

#### Conclusion.

The petition for a writ of certiorari should be granted.

Respectfully submitted,

J. BERNHARD THIESS,

*Counsel for Paul A. Sturtevant,  
as amicus curiae.*

BERTRAM WM. COLTMAN,

SIDNEY NEUMAN,

*Of Counsel.*



## APPENDIX A.

### STATUTES INVOLVED.

Patent Act of 1836 (Act of July 4, 1836, ch. 357, 5 Stat. 117):

"SECTION 7. *And be it further enacted*, That on the filing of any such application, description, and specification, and the payment of the duty hereinafter provided, the Commissioner shall make, or cause to be made, an examination of the alleged new invention or discovery; and if, on any such examination, it shall not appear to the Commissioner that the same had been invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant, or that it had been patented, or described in any printed publication in this or any foreign country, or had been in public use or on sale with the applicant's consent or allowance prior to the application, if the Commisisoner shall deem it to be sufficiently useful and important, it shall be his duty to issue a patent therefor. . . . if the specification and claim shall not have been so modified as, in the opinion of the Commissioner, shall entitle the applicant to a patent, he may, on appeal, and upon request in writing, have the decision of a board of examiners, to be composed of three disinterested persons, who shall be appointed for that purpose by the Secretary of State, . . . it shall be in their power, or of a majority of them, to reverse the decision of the Commissioner, either in whole or in part, and their opinion being certified to the Commissioner, he shall be governed thereby in the further proceedings to be had on such application. . . ."

"SECTION 8. *And be it further enacted*, That whenever an application shall be made for a patent which, in the opinion of the Commissioner, would interfere



with any other patent for which an application may be pending, or with any unexpired patent which shall have been granted, it shall be the duty of the Commissioner to give notice thereof to such applicants, or patentees, as the case may be; and if either shall be dissatisfied with the decision of the Commissioner on the question of priority of right or invention, on a hearing thereof, he may appeal from such decision, on the like terms and conditions as are provided in the preceding section of this act; and the like proceedings shall be had, to determine which or whether either of the applicants is entitled to receive a patent as prayed for. . . ."

"SECTION 16. *And be it further enacted*, That whenever there shall be two interfering patents, or whenever a patent on application shall have been refused on an adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted, any person interested in any such patent, either by assignment or otherwise, in the one case, and any such applicant in the other case, may have remedy by bill in equity; and the Court having cognizance thereof, on notice to adverse parties, and other due proceedings had, may adjudge and declare either the patents void in the whole or in part, or inoperative or invalid in any particular part or portion of the United States, according to the interest which the parties to such suit may possess in the patent or the inventions patented, and may also adjudge that such applicant is entitled, according to the principles and provisions of this act, to have and receive a patent for his invention, as specified in his claim, or for any part thereof, as the fact of priority of right or invention shall in any such case be made to appear. And such adjudication, if it be in favor of the right of such applicant, shall authorize the Commissioner to issue such patent, on his filing a copy of the adjudication, and otherwise complying with the requisitions of this act. *Provided however*, That no such judgment or adjudication shall affect the rights of any person except the parties to the action

and those deriving title from or under them subsequent to the rendition of such judgment."

Patent Act of 1839 (Act of March 3, 1839, ch. 88, 5 Stat. 353):

"SECTION 10. *And be it further enacted*, That the provisions of the sixteenth section of the before-recited act shall extend to all cases where patents are refused for any reason whatever, either by the Commissioner of Patents or by the Chief Justice of the District of Columbia, upon appeals from the decision of said Commissioner, as well as where the same shall have been refused on account of, or by reason of, interference with a previously existing patent; and in all cases where there is no opposing party, a copy of the bill shall be served upon the Commissioner of Patents, when the whole of the expenses of the proceeding shall be paid by applicant, whether the final decision shall be in his favor or otherwise."

"SECTION 11. *And be it further enacted*, That in all cases where an appeal is now allowed by law from the decision of the Commissioner of Patents to a board of examiners, provided for in the seventh section of the act to which this is additional, the party, instead thereof, shall have a right to appeal to the Chief Justice of the district court of the United States for the District of Columbia, by giving notice thereof to the Commissioner, and filing in the Patent Office, within such time as the Commissioner shall appoint, his reasons of appeal specifically set forth in writing, and also paying into the Patent Office, to the credit of the patent fund, the sum of twenty-five dollars. And it shall be the duty of said Chief Justice, on petition, to hear and determine all such appeals, and to revise such decisions in a summary way, on the evidence produced before the Commissioner, at such early and convenient time as he may appoint..."

Consolidated Patent Act of 1870 (Act of July 8, 1870, ch. 230, 16 Stat. 198):

"SECTION 52. *And be it further enacted*, That whenever a patent on application is refused, for any reason

whatever, either by the commissioner or by the Supreme Court of the District of Columbia upon appeal from the commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent, on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requisitions of law. And in all cases where there is no opposing party a copy of the bill shall be served on the commissioner, and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not."

"SECTION 58. *And be it further enacted*, That whenever there shall be interfering patents, any person interested in any one of such interfering patents, or in the working of the invention claimed under either of such patents, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court having cognizance thereof, as hereinbefore provided, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either of the patents void in whole or in part, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the rights of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment."

Revised Statutes of 1874. § 4911 (35 U. S. C. 59a).

"If any applicant is dissatisfied with the decision of the board of appeals, he may appeal to the United States Court of Customs and Patent Appeals, in which

case he waives his right to proceed under section 63 of this title.\* If any party to an interference is dissatisfied with the decision of the board of interference examiners, he may appeal to the United States Court of Customs and Patent Appeals, provided that such appeal shall be dismissed if any adverse party to such interference shall, within twenty days after the appellant shall have filed notice of appeal according to section 60 of this title, file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 63. Thereupon the appellant shall have thirty days thereafter within which to file a bill in equity under said section 63, in default of which the decisions appealed from shall govern the further proceedings in the case. R. S. § 4911; March 2, 1927, c. 273, § 8, 44 Stat. 1336; March 2, 1929, c. 488, § 2, 45 Stat. 1476; Aug. 5, 1939, c. 451, § 3, 53 Stat. 1212."

§ 4915 (35 U. S. C. § 63).

"Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, *unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section,*\*\* may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in

\* Italicized matter added by amendment by Act of March 2, 1927, c. 273, § 8, 44 Stat. 1336.

\*\* Italicized matter added by amendment by Act of March 2, 1927, c. 273, § 11, 44 Stat. 1336.

the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit. R. S. § 4915; February 9, 1893, c. 74, § 9, 27 Stat. 436; March 2, 1927, c. 273, § 11, 44 Stat. 1336; March 2, 1929, c. 488, § 2(b), 45 Stat. 1476; August 5, 1939, c. 451, § 4, 53 Stat. 1212."

## APPENDIX B.

IN THE UNITED STATES COURT OF APPEALS FOR THE  
DISTRICT OF COLUMBIA.

The Hoover Company,  
*Appellant,*

*vs.*

Conway P. Coe, Commissioner of  
Patents,  
*Assignee.*

No. 8602.

### MEMORANDUM.

This suit is stated to have been brought under the provisions of Section 4915 R. S. (U. S. C., title 35, sec. 63) which provides that whenever a patent on application is refused by the Board of Appeals, the applicant may, under certain specified conditions, have remedy by a bill in equity, if filed within the period specified.

The statute provides:

• • • and the court having cognizance thereof • • • may adjudge that the applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear • • • • • And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law.



Counsel have been asked to furnish a memorandum on the following question:

Has the Court under Section 4915 R. S., the power to hand down a decree which does not determine the right of an applicant to receive a patent but which only determines that claims which may subsequently be held to be unpatentable by the Patent Office are supported by the application?

It is thought that the proper answer to the question can be better determined if a brief summary is made of the patent laws as they were from time to time enacted to define so far as they specify the procedure leading up to the grant of a patent.

In the first patent act of 1790, it was provided that upon petition of any person to the Secretary of State, Secretary of the Department of War, and the Attorney General, setting forth that the petitioner had invented, or discovered, any useful art, manufacture, etc. not known or used before the filing of the petition and praying that a patent may be granted therefor, it will be lawful for the Secretary of State, Secretary of the Department of War, and the Attorney General, or any two of them, to cause the Letters Patent to be made out in the name of the United States and for a term of not to exceed 14 years, if it should be deemed the invention or discovery is sufficiently useful or important. There was no requirement that any such examination on the part of the Government, as was specifically required in later acts, should be made.

It is to be noted that, while there was no such requirement in the statute, it is a tradition that Thomas Jefferson, who was then Secretary of State, gave careful consideration to every patent application to determine whether, in his judgment, the invention was, as stated in the act, sufficiently useful and important.

The next act, of 1793, provided in effect that a patent should be granted upon a proper application being made therefor. It also provided (Sec. 3) that every inventor before he can receive a patent shall make oath that he "does verily believe that he is the true inventor or discoverer of the art, machine, or manufacture for which he solicits a patent." This act remained in force with some slight amendments, which are not material to the question here involved, until the act of 1836.

That later act created the Patent Office and provided for the appointment of a Commissioner of Patents. It was this act that created the examination system.

Section 6 of the act provided that any person who had discovered or invented any new and useful art, machine, manufacture, or improvement thereon and which was not known or used by others before his invention or discovery and not, at the time of his application for patent, in public use or on sale with his consent or allowance, may make application in writing to the Commissioner of Patents and the Commissioner, "on due proceedings had, may grant a patent therefor."

The act further provided (Sec. 7) that when such an application is filed, "the commissioner shall make or cause to be made an examination of the alleged new invention or discovery and if on any such examination it shall not appear to the Commissioner that the same had been invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant or that it had not been patented or described in any printed publication in this or any foreign country or had not been in public use or on sale with the applicant's consent or allowance prior to the application, if the Commissioner shall deem it to be sufficiently useful and important, it shall be his duty to issue a patent therefor."



That section further provided that if, upon examination, "it shall appear to the Commissioner that the applicant was not the original and first inventor or discoverer thereof or any part of that which is claimed as new had before been invented, discovered, or patented, or described in any printed publication in this or any foreign country, as aforesaid, . . . he shall notify the applicant thereof, giving him briefly such information and references as may be useful in judging of the propriety of renewing his application, or altering his specification, to embrace only that part of his invention or discovery which is new."

The act did not provide for an appeal to any court, but did provide (Sec. 7) for an appeal from the Commissioner to a board of examiners to be composed of three disinterested persons who should be appointed for that purpose by the Secretary of State and that it should be in the power of that board to reverse the decision of the Commissioner, who should in the further proceedings be governed by the decision of the board.

There was, however, a provision (Sec. 16) somewhat analogous to present Section 4915 R. S., which provided that whenever a patent on an application had been refused on an adverse decision of the Board of Examiners on the ground that the patent applied for would interfere with an unexpired patent, previously granted, the applicant might have a remedy by a bill in equity and that the court may "adjudge that such applicant is entitled according to the principles and provisions of this act to have and receive a patent for his invention, as specified in his claims or any part thereof."

By the act of 1839 (Sec. 10) it was provided that the provisions of Section 16 of the Act of 1836 is extended to all cases where patents are refused for any reason whatever either by the Commissioner of the Patent Office of the

Chief Justice of the District Court, (Section 11 of the act providing for such an appeal).

This practice was continued without interruption until the passage of what is known as the "consolidated act" of 1870.

The latter act continued the requirement that an examination be made by the Commissioner, or made under his direction, and contains the provision (Sec. 31), that when an application is filed and the fee is paid, "The Commissioner shall cause an examination to be made of the alleged invention or discovery and if, on such an examination, it shall appear that the claimant is justly entitled to a patent under the law and the same is sufficiently useful and important, the Commissioner shall issue a patent therefor." (See present section 4893 R. S., U. S. C., title 35, sec. 36.) Section 52 of the act of 1870 is substantially the same as section 4915 R. S. as in force up to the time of amendment of 1927, which latter has no bearing on the question here involved.

It would seem that, since the Commissioner is required to have an examination made and on that examination, if any ground therefor should appear, to refuse to grant the patent, it must be presumed that he had found no other grounds.

The rules of the Patent Office have for many years expressly provided (Rule 66) that the Examiner upon taking up the application for examination shall make a thorough investigation of the prior art with respect to the invention sought to be protected in the application and that the Examiner must cite the best references at his command. When therefore, after the Board of Appeals affirms the action of an examiner refusing a patent, it would seem that, if in the suit under Section 4915 R. S. the court is of the opinion that the Board of Appeals was in error in

refusing the patent on the grounds stated, it would be proper for it to make a finding as specified in said section.

It is true that an action under that section has been held to be an action *de novo* and that the Commissioner of Patents may bring forward, with proper notice, other grounds for rejection than those stated by the Examiner and the Board of Appeals, but again, the presumption would seem to be that the Patent Office has brought before the court the best evidence that was available and therefore, if that evidence is not deemed sufficient to justify dismissing the bill, the applicant is entitled to the finding as specified in Section 4915 R. S.

In so far as the authority of the court to make the finding, when it is known that further action would be required in the Patent Office even though that finding was favorable to the plaintiff, is concerned, it would seem that such a proceeding is contemplated by the statute for it is provided that the patent may be granted upon the applicant "filing in the Patent Office a copy of the adjudication and otherwise complying with the law."

While the language of the section might appear to make the finding mandatory and immediately effective, it is thought that it is proper to consider it as a part of the entire patent law and hence coordinate with section 4904 R. S., which provides for the declaration of an interference where an application for patent is found to be in conflict with another application, or an unexpired patent. It is not until it is found that a claim in an application is patentable to the applicant, that such a conflict exists. Therefore when it is determined by the adjudication of the court that the conflict exists, Section 4904 R. S. comes into play and the interference must be declared, notwithstanding the form of the judgment. Any other construction would exclude an applicant whose claims copied from a patent

had been rejected, and a patent containing those claims "refused," from availing himself of the right, clearly stated in Section 4915 R. S., of filing a bill in equity instead of filing an appeal to the United States Court of Customs and Patent Appeals, as provided in Section 4911 R. S.

So far as can be ascertained, no question has ever been raised as to the right of the Patent Office to proceed in accordance with other sections of the patent statutes, if an adjudication is made favorable to the plaintiff in a 4915 R. S. suit.

In the case of *Tully v. Robertson*, 19 F. (2d) 954, the District Court of Maryland, Soper, Judge, held specifically that the applicant was entitled to make certain claims copied from a patent and the subsequent record of the application shows that after a copy of that adjudication was filed an interference was declared.

Furthermore, in the case of *Pitman v. Ellis-Foster Co. v. Coe*, 62 App. D. C. 365, 68 F. (2d) 412, 1934 C. D. 34, it appears that in an application division had been required by the Patent Office, that is to say, that the patent had been refused because, in the opinion of the Patent Office, there was a misjoinder of inventions, and it appears further that in the suit brought under Section 4915 R. S. the Solicitor of the Patent Office moved in the District Court to dismiss the complaint on the ground that the refusal to issue the patent was based only on the ground that it would not be examined until the requirement for division had been complied with. That motion was granted but, on appeal to this Court, it was specifically held that the suit was improperly dismissed and the decision was reversed.

This Court, speaking through Chief Justice Martin, Associate Justices Robb and Groner concurring, after stating

the facts and that the lower court had sustained the defendant's motion to dismiss, said:

"We think the ruling was erroneous."

The Court discussed at some length the two remedies provided by an appeal under Section 4911 R. S. and a suit under Section 4915 R. S., and noted that instead of the applicant having a right to take the appeal first and then file a bill in equity, if the decision on the appeal was adverse to him, the law had been amended in 1927 to limit the applicant to only one of these provisions as he should elect, and then said:

"\* \* \* These two remedies lie to different courts. They differ in procedure, the one is an appeal upon the record of the Patent Office, and the other is an original suit in a court of equity. The latter proceeding calls for a trial *de novo* with all the customary power of an equity court to hear the evidence fully and to make its own findings. Although these two methods of procedure are alternatives, they are nevertheless analogous and are designed to secure essentially the same legal remedy."

The Court noted that it had been definitely decided that an appeal may be taken from a refusal of a patent based on a requirement for division made by the Patent Office (citing *Steinmetz v. Allen*, 192 U. S. 543, and *In re Frasch*, 27 App. D. C. 25, and *In re Wellman*, 18 C. C. P. A. 1214, 48 F. (2d) 926) and then said:

"\* \* \* We can see no reason for holding that such a remedy is confined to a review by the appellate court of the decisions of the Patent Office, and is denied in proceedings brought by the applicant for review in a court of equity. It is true that the remedies are diverse; nevertheless the substantive rights of the applicants, which are the basis alike of the appeal and bill in equity, are identical. There is no reason to believe that Congress intended that any remedy which might be obtained by appeal should be more extensive



or complete than that allowed by bill in equity. It follows that a refusal to grant a patent based upon a controversy arising from an order of division is reviewable by either proceeding. The difference between the two is a difference of procedure rather than a difference of interest. In this view of the case we think that the lower court possessed jurisdiction to hear and decide the question notwithstanding that the refusal of the patent was based upon an order of division of claims made in the Patent Office."

It would seem therefore that, at least tacitly, this Court has construed the language of Section 4915 R. S. as not prohibiting an applicant, who has been refused a patent, the right to proceed thereunder, even though it appears from the pleadings that further action by the Patent Office will be required, if the adjudication of the court is in favor of the plaintiff.

Furthermore there have been several appeals to this court in suits brought under Section 4915 R. S., in which it appeared from the pleadings that the refusal of the Patent Office to grant the patent was based on the ground of an estoppel arising from the failure to proceed under the provisions of Rule 109 of the Patent Office. It would clearly appear in these cases that a decree for the plaintiff would determine only that the refusal of the claims was in error and these claims "might be subsequently held to be unpatentable" to the plaintiff.

Attention is specifically called to *International Cellulose Products Co. v. Coe*, 66 App. D. C. 248, 85 F. (2d) 59, which was heard by the full Bench of five judges, and *American Cyanamid Co., et al. v. Coe*, 70 App. D. C. 330, 86 F. (2d) 851, which was heard by Chief Justice Groner, and Associate Justice Stephens and Edgerton, both opinions being written by Justice Stephens.

In these cases also it was, at least tacitly, held that the suits were properly brought.



The files of these cases show that the interferences, which had been dissolved, were reinstated and prosecuted to a final decision.

The present Hoover case is of the same character as that of the two foregoing cases, since in each of the three a judgment in favor of the plaintiff puts the involved application within the requirement of Section 4904 for the declaration of an interference.

It has been suggested that a suit under Section 4915 R. S. may be likened to a suit for a declaratory judgment and that the adjudication authorized by that section is such a judgment. Professor Borchard, in his book on Declaratory Judgments (2nd Edition, page 802), with reference to Section 4915 R. S., says:

"The equity suit of an unsuccessful applicant for a patent authorized by section 4915 of the Revised Statutes is an adjudication of his right or no-right, as the case may be, as against adverse claimants or the Commissioner of Patents. It seems preferable to consider a favorable judgment as declaratory rather than investitive, for while it adjudicates the applicant's rights to a new status, it in effect declares a pre-existing right that the Commissioner should have recognized and merely enables him, on compliance with further legal requirements, to obtain his patent administratively."

This statement seems to fully support the conclusion that the answer to the question propounded is that the Court, under the circumstances stated, has the authority to hand down a judgment in the form stated in Section 4915 R. S.

Respectfully,

R. F. WHITEHEAD,  
*Of Counsel, for the Commissioner of  
Patents.*

April 18, 1944.

# SUPREME COURT OF THE UNITED STATES.

No. 486.—OCTOBER TERM, 1944.

The Hoover Company, Petitioner, } On Writ of Certiorari to the  
vs. } United States Court of  
Conway P. Coe, Commissioner of } Appeals for the District  
of Patents. } of Columbia.

[April 30, 1945.]

Mr. Justice ROBERTS delivered the opinion of the Court.

The question presented is whether a District Court has jurisdiction of a suit under R. S. 4915<sup>1</sup> to review the refusal of a claim for patent as not reading on the application. The court below answered in the negative.

The respondent confesses error: The language of the Act, its legislative history, administrative practice, and judicial construction, constrain us to hold that the District Court had jurisdiction of the suit and that the Court of Appeals should have reviewed its decision upon the merits.

January 10, 1941, the petitioner's assignor filed application for reissue of a patent granted November 7, 1939, on an original application of August 8, 1936. The alleged invention is for improvements in a refrigerating system. A number of claims included in the application for reissue were copied, or substantially copied, from several later patents, in order to provoke interferences therewith and a contest as to priority of invention.

The Primary Examiner finally rejected four of the claims, stating that they were rejected "as not reading on applicant's disclosure". . . . The Board of Appeals of the Patent Office affirmed the Examiner's decision. The petitioner then brought suit against the Commissioner of Patents under R. S. 4915 in the United States District Court for the District of Columbia, to compel him to allow the four claims, to the end that interference proceedings might be instituted. The case was heard on the Patent Office record and additional evidence. The court entered findings of fact and conclusions of law and dismissed the complaint on the ground that the claims did not read on, that is, did not accurately describe, the disclosure in the application.

On appeal the court below on its own motion raised the question whether [R. S. 4915] confers jurisdiction on the District Court

to enter a decree which does not determine the right of the applicant to receive a patent but which instead directs the examiner to allow claims for the purpose of provoking subsequent interference proceedings". The parties were heard upon this question and the court decided that the District Court lacked jurisdiction of the suit, and on that ground affirmed its judgment of dismissal.<sup>2</sup>

R. S. 4915 is in part:

"Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not."

The court below held that in conformity to the general rule, a court of equity ought not to afford piecemeal relief pending completion of the administrative process, and consequently ought not to entertain a suit under the statute unless its adjudication would conclude all possible questions as to the right to a patent.

1. On its face the statute confers the right to sue "Whenever a patent on application is refused by the Board of Appeals". The patent applied for (that is, the claims in question) was finally refused by the Board of Appeals. No appeal was taken to the United States Court of Customs and Patent Appeals, and petitioner filed its bill within the time limited in the section.

Two matters may be noted respecting R. S. 4915. These are the denial of jurisdiction if appeal has been taken to the United States Court of Customs and Patent Appeals and the statement that adjudication in favor of the applicant shall authorize the Commissioner to issue a patent. These provisions require reference to R. S. 4911, as amended. That section provides:

"If any applicant is dissatisfied with the decision of the board of appeals, he may appeal to the United States Court of Customs and Patent Appeals, in which case he waives his right to proceed under section 63 [R. S. 4915] of this title. If any party to an interference is dissatisfied with the decision of the board of interference examiners, he may appeal to the United States Court of Customs and Patent Appeals: *Provided*, That such appeal shall be dismissed if any adverse party to such interference shall, within twenty days after the appellant shall have filed notice of appeal according to section 60 of this title, file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in Section 63 [R. S. 4915]. Thereupon the appellant shall have thirty days thereafter within which to file a bill in equity under said section 63 [R. S. 4915], in default of which the decisions appealed from shall govern the further proceedings in the case."

It is evident that alternative rights of review are accorded an applicant,—one by appeal to the United States Court of Customs and Patent Appeals, the other by bill in equity filed in one of the federal district courts. In the first the hearing is summary and solely on the record made in the Patent Office<sup>3</sup>; in the other a formal trial is afforded on proof which may include evidence not presented in the Patent Office.<sup>4</sup> Every party adversely affected by a ruling on the merits may, if he so elect, proceed by bill rather than by appeal. In the one case the adjudication in equity authorizes issue of a patent on the applicant's "otherwise complying with the requirements of law". In the other the decision "shall govern the further proceedings in the case" in the Patent Office.<sup>5</sup>

The question is whether the differences in the character of the proceedings and the statutory effect of decision or adjudication require a holding that as to all decisions on the merits adverse to the applicant, other than the final action as to the issue of a patent, the applicant must obtain review by appeal to the Court of Customs and Patent Appeals, and can proceed by bill under R. S. 4915<sup>6</sup> only when every step requisite to issue has been taken. If so, the language of R. S. 4915 is ill chosen. "Whenever a patent on application is refused" states precisely this case. "The petitioner's application was refused." "Whenever any applicant is dissatisfied with the decision of the board of interference examiners" states a case where the examiner's decision may be only one of a series of rulings in the Patent Office prior to issue of a patent. It can hardly be that these phrases have no effect and

<sup>3</sup> See R. S. 4914, 35 U. S. C. § 62.

<sup>4</sup> *Butterworth v. Hoe*, 112 U. S. 50, 61.

<sup>5</sup> R. S. 4911, *supra*.

are to be read as "Whenever, after all administrative steps are complete and a patent is about to issue, any person aggrieved may have remedy by bill in equity". If that be the correct construction, one finally denied a patent could not resort to the specified remedy, since, even if his contention were sustained, he might thereafter have to leap the hurdles in the Patent Office of interferences, later references, and other obstacles to patentability.

On the face of the statutes the applicant is given alternative remedies resulting in the same sort of relief so far as concerns the further prosecution of the application in the Patent Office.

2. The legislative history confirms the view that Congress so intended.

That history cannot be stated briefly. It has its origin in the Patent Act of 1836<sup>6</sup> which afforded an applicant aggrieved by a ruling of the Commissioner an appeal to a board of examiners.<sup>7</sup> By a later section it was provided that "whenever a patent on application shall have been refused on an adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent", the applicant might have remedy by bill in equity; and the court might adjudge the applicant entitled to a patent, according to his claim or any part of it. Adjudication favorable to the applicant was to "authorize the Commissioner to issue such patent" on the applicant's filing a copy of the adjudication "and otherwise complying with the requisitions of this act."<sup>8</sup> It will be noted that a bill might be filed under this statute only where the rejection of a claim was for interference with an outstanding patent. By the Act of March 3, 1837,<sup>9</sup> the same remedy was afforded an applicant for patent for an improvement or for "correction and re-issue."

By the Act of March 3, 1839,<sup>10</sup> the same remedy was extended "to all cases where patents are refused for any reason whatever, either by the Commissioner of Patents, or by the chief justice of the District of Columbia, upon appeals from the decision of said Commissioner", as well as where the refusal was based on asserted interference. The reason for adding the phrase concerning the decision of the Chief Justice was that, by Sec. 11<sup>11</sup> of the same Act, a summary appeal on the Patent Office record to

<sup>6</sup> 5 Stat. 117.

<sup>7</sup> Sec. 7, 5 Stat. 119-120.

<sup>8</sup> Sec. 16, 5 Stat. 123.

<sup>9</sup> 5 Stat. 191.

<sup>10</sup> Sec. 10, 5 Stat. 354.

<sup>11</sup> 5 Stat. 354.



this judicial officer, was substituted for the former appeal to a board of examiners given by the Act of 1836.<sup>12</sup>

Thus a District Court might set aside, on bill filed, any ruling refusing a patent, either on interference or otherwise, whether the ruling were that of the Patent Office or of a judge of the Circuit Court of the "District of Columbia on appeal from the Patent Office decision.

The Act of July 8, 1870,<sup>13</sup> amended, revised, and consolidated existing law. In Sec. 48<sup>14</sup> it enacted that in *ex parte* cases an applicant for patent or reissue whose claims had been twice rejected might appeal to the Supreme Court of the District of Columbia. The hearing was to be summary, to be on the office record, and the decision was "to govern the further proceedings in the case."<sup>15</sup> In Sec. 52 it provided that whenever a patent on application "is refused, for any reason whatever", either by the Commissioner or by the Supreme Court of the District upon appeal, the remedy by bill in equity should be available. The adjudication was to authorize the issue of a patent on the applicant's filing a copy in the patent office "and otherwise complying with the requisitions of law." This statute was construed to require an appeal to the District Supreme Court as a condition precedent to the maintenance of a bill in equity.<sup>16</sup>

The provisions of the Act of 1870 were codified in the Revised Statutes of 1873.<sup>17</sup> In the process the words "for any reason whatever" were deleted from Sec. 52, which became R. S. 4915. The omission was evidently because the words were surplusage, since the purpose of the revisers was not "to attempt any change whatever in the existing law" except "mere changes of phraseology, not affecting the meaning of the law."<sup>18</sup>

By the Act of February 9, 1893<sup>19</sup> the Court of Appeals for the District of Columbia was created and jurisdiction of summary appeals from Patent Office rulings was transferred to that court. Thus the remedy by bill in equity was now to be pursued in a District court only after an appeal to the Court of Appeals of

<sup>12</sup> By the Act of August 30, 1852, 10 Stat. 75, such summary appeal might be heard by any judge of the Circuit Court of the District of Columbia.

<sup>13</sup> 16 Stat. 198.

<sup>14</sup> 16 Stat. 205.

<sup>15</sup> Sec. 50, 16 Stat. 205.

<sup>16</sup> *Kirk v. Commissioner of Patents*, C. D. 440; *Fekete v. Robertson*, 17 F. 2d 335; *Cooper v. Robertson*, 38 F. 2d 852.

<sup>17</sup> The relevant sections are 4911-15 inclusive.

<sup>18</sup> 2 Cong. Rec. 646.

<sup>19</sup> 27 Stat. 434, 436.



the District had resulted adversely to the applicant; and an adjudication in the equity suit was subject to review on appeal.

So matters stood until the passage of the Act of March 2, 1927.<sup>20</sup> In the hearings on the bill which became the statute, it was proposed that Congress eliminate either the appeal or the bill in equity, some interested parties suggesting abolition of the one remedy, others advocating dropping the other. Congress decided not to do away with either, but to allow an applicant to have the decision of the Patent Office reviewed either by the court of appeals or by filing a bill in equity, but not both.<sup>21</sup> It is evident that no alteration in respect of the rulings which could be reviewed was intended; but the number of possible appeals was to be reduced, while saving to litigants the option of producing new evidence in a court, by retaining the equity procedure.<sup>22</sup>

Finally, the Act of March 2, 1929<sup>23</sup> transferred from the Court of Appeals of the District to the Court of Customs and Patent Appeals jurisdiction of appeals from the Patent Office, but *ex industria* provided "Nothing contained in this Act shall be construed as affecting in any way the jurisdiction of the Court of Appeals of the District of Columbia in equity cases." This was of course to make it plain that suits in the District Court of the District of Columbia should be appealable as are suits under R. S. 4915 instituted in district courts in circuits outside the District.

Thus it is clear that throughout more than a century Congress has for correction of erroneous adverse rulings, which if unreviewed would end the proceedings in the Patent Office, preserved the remedy by bill in a district court either as additional to or alternative to that by summary appeal and has made the effect of adjudication in equity the same as that of decision on appeal.

3. The Commissioner of Patents states that "when claims are finally rejected by the examiner and his action is affirmed by the Board of Appeals, the grounds then stated for such rejection, as well as any other grounds in support thereof, may be set up by

<sup>20</sup> 44 Stat. 1335.

<sup>21</sup> H. R. No. 1889, pp. 2-3; S. R. No. 1313, p. 4, 69th Cong., 2d Sess.

<sup>22</sup> See H. R. 1889, *supra*, p. 3; Hearings, House Committee on Patents, on H. R. 6252 and H. R. 7087, 69th Cong., 1st Sess., pp. 21, 22; Hearings, House Committee on Patents, on H. R. 7563 and H. R. 13487, 69th Cong., 2d Sess., p. 11; Hearings, Senate Committee on Patents, on S. 4812, 69th Cong., 2d Sess., p. 35; Hearings, House Committee on the Judiciary, on H. R. 6687, 70th Cong., 1st Sess., *passim*; cf. Hearings, House Committee on Patents, on H. R. 7563 and H. R. 13487, 69th Cong., 2d Sess., p. 31; Hearings, House Committee on Patents on H. R. 6252 and H. R. 7087, 69th Cong., 1st Sess., p. 79.

<sup>23</sup> 45 Stat. 1475.

this Office in answer to a subsequent suit by the applicant under Rev. Stat. 4915. If the adjudication by the court is favorable to the applicant, it is the practice of this Office to treat that judgment as conclusive with respect to any ground of rejection urged before the court in defense of the refusal to allow the claims in issue. In the usual case, following such adjudication, the application is allowed and, upon payment of the prescribed fee, the patent is issued. However in rare instances where, after termination of the suit, new reference is discovered which shows lack of patentability of the claims for a reason not considered by the court, this Office considers itself under a duty to reject the claims on the newly discovered ground, and to refuse a patent on those claims unless the applicant can overcome the new ground of rejection. Similarly, if another applicant or a patentee is claiming substantially the same subject matter as that held patentable in the Rev. Stat. 4915 suit and a question of priority arises, interference proceedings may be necessary under Rev. Stat. 4904 to determine which of the adverse claimants is the first inventor. The foregoing is believed to have been the consistent practice of this Office for many years.

4. This court has repeatedly indicated a view of the meaning of R. S. 4915 which is inconsistent with the decision below,<sup>24</sup> although the exact question here presented was not involved in the cases under adjudication. The lower federal courts have consistently construed the section as conferring jurisdiction in cases which are indistinguishable from that at bar.<sup>25</sup> They have so held in cases where it affirmatively appeared that further proceedings in the Patent Office would be necessary following adjudication in favor of the applicant,<sup>26</sup> and where though it did not appear of record that further proceedings would be required in the Patent Office, it was evident that they might ensue adjudication, as where a patent was denied for want of invention.<sup>27</sup>

<sup>24</sup> *Gandy v. Marble*, 122 U. S. 432, 439; *In re Hien*, 166 U. S. 433, 439; *Asch v. Moore*, 211 U. S. 1, 89; *American Foundries Co. v. Robertson*, 262 U. S. 209, 212-213; *United States v. The Baldwin Co. v. Robertson*, 265 U. S. 168, 180-181.

<sup>25</sup> *Dilig v. Moore*, 34 App. D. C. 106; *E. I. du Pont de Nemours & Co. v. Coe*, 89 F. 2d 679; *Pitman v. Coe*, 68 F. 2d 412; *Power Patents Co. v. Coe*, 10 F. 2d 550; *Tully v. Robertson*, 19 F. 2d 954; *Monopower Corp. v. Coe*, 10 F. Supp. 934; *Booth Fisheries Corp. v. Coe*, 114 F. 2d 462; *Forward v. Coe*, 116 F. 2d 946.

<sup>26</sup> *Pitman v. Coe*, *supra*; *International Cellucotton Co. v. Coe*, 85 F. 2d 851; *American Cyanamid Co. v. Coe*, 106 F. 2d 851.

<sup>27</sup> *American Steel & Wire Co. v. Coe*, 105 F. 2d 17; *Abercrombie v. Coe*, 105 F. 2d 458; *General Motors Corp. v. Coe*, 120 F. 2d 736; *Radtke Patents*

And, where an applicant has succeeded in a bill filed under R. S. 4915, the courts have not questioned the power of the Patent Office subsequently to disallow the claims for want of invention over a newly discovered reference to the prior art.<sup>28</sup>

The court below relied upon *Hill v. Wooster*, 132 U. S. 693, for its holding that a suit under R. S. 4915 cannot select a single issue which affects the applicant's right to a patent, without determining all the other issues on which that right depends. That case was one in which the Commissioner had decided an interference between the claims of two applicants in favor of one of them, and ordered that a patent issue. In an *inter partes* suit by the unsuccessful applicant against the successful one, this court held that if it appeared that neither application disclosed invention (a matter which should have moved the Commissioner not to declare an interference) the bill should be dismissed.<sup>29</sup> The court did not purport to decide what Patent Office rulings are reviewable under R. S. 4915.<sup>30</sup>

The ruling of the Board of Appeals in the instant case was neither a procedural ruling<sup>31</sup> nor an interlocutory one<sup>32</sup> as to which the District Court should not entertain a suit under R. S. 4915. On the contrary, it finally denied a patent on the claims presented. In this respect it was like a dismissal of a suit in a court. Unless the applicant could sue to correct error in that dismissal, he could never sue under R. S. 4915. That he was accorded a right of suit in this case the language of the statute, its history, the administrative construction and judicial decision unite in affirming.

The judgment is reversed and the cause remanded for further proceedings in conformity to this opinion.

*Corp. v. Coe*, 122 F. 2d 937; *Hydraulic Press Corp. v. Coe*, 124 F. 2d 521; *Minnesota Mining & Mfg. Co. v. Coe*, 125 F. 2d 198; *Poulson v. McDowell*, 142 F. 2d 267.

<sup>28</sup> *Gold v. Newton*, 254 Fed. 824.

<sup>29</sup> Section 16 of the Act of 1836 (5 Stat. 123) *supra* expressly provided that upon a bill filed as a result of Patent Office decision on an interference the court might adjudge either of the patents void in whole or in part. This language was evidently omitted in later acts as surplusage, for obviously if either patent was void for lack of invention or other cause, the question of interference disappeared.

<sup>30</sup> This is equally true of *Radtke Patents Corp. v. Coe*, 122 F. 2d 937, on which the court below relied.

<sup>31</sup> *Butterworth v. Bee*, 112 U. S. 50; *Shoemaker v. Robertson*, 54 F. 2d 456; *Chessin v. Robertson*, 63 F. 2d 267; *Cherry-Burrell Corp. v. Coe*, 143 F. 2d 372.

<sup>32</sup> *American Cable Co. v. John A. Roebling's Sons Co.*, 65 F. 2d 801; *Synthetic Plastics Co. v. Ellis-Foster Co.*, 78 F. 2d 847.

